

REMARKS

Claims 1-21 are pending in the current application. Claims 1 and 11 are independent claims.

Claim Rejections – 35 U.S.C. § 103 (Sewall and Huang)

Claims 1-21 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sewall et al (US 6,708,146, hereinafter Sewall) in view of Huang et al (US 6,018,706). Applicant respectfully traverses this art grounds of rejection.

The alleged motivation cited by the Examiner for combining Sewall and Huang to reject independent claims 1 and 11, is to “provide a more accurate representation of the speech samples.”

Applicant asserts that the Examiner’s alleged motivation is based upon Applicant’s own disclosure and previous responses, and is therefore an improper use of hindsight. The Examiner merely viewed the present application and intended to select prior art containing “an autocorrelation periodicity function” without citing specific evidence of motivation to combine the references, other than providing conclusory statements regarding motivation and obviousness. The Examiner simply cites a single paragraph of Huang (see Office Action page 3) which in fact has nothing to do with the representation of speech samples. Accordingly, absent evidence of such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.¹

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable.² Broad conclusory statements standing alone are not "evidence".

Neither Sewall nor Huang teach or suggest combining their features to arrive at independent claim 1; nor does the Examiner cite any particular passage which provides evidence that such a combination would be obvious to one of ordinary skill in the art. On the contrary, the disclosed references seek to overcome differing problems and therefore do not constitute an obvious combination. Sewall is directed to a **method of signal classification** to determine which type of voice-band traffic is being carried (Sewall, col. 1, lines 9-20, and col. 2, lines 22-42). Huang is directed to an **apparatus to digitally encode voice messages** for high compression for mixing with data sent over a communications channel (Huang, col. 3, lines 34-45).

Given the distinct and differing problems solved by the references, neither reference provides any evidence, teaching or suggestion of any combination. Thus, it would not have been obvious to one of ordinary skill in the art to combine the teachings of Sewall and Huang.

¹ See *Dembiczak*, 50 USPQ at 1614 (Fed.Cir. 1999).

² See *Dembiczak*, 50 USPQ2d at 1617.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion to motivate such a combination is not a proper standard for reaching the conclusion of obviousness. There must be some reasoning as to why one of ordinary skill would combine the references to reach the claimed invention. The Examiner has not provided such reasoning.

In view of the above arguments, Applicant asserts that the Examiner has not established the required motivation for combining the teachings of Sewall and Huang and therefore fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

The Examiner has also asserted that the combination of Sewall and Huang teaches the limitations of claims 5-9 (Office Action, page 4). However, the Examiner has not shown how the combination meets the particular limitations of the claims. For instance, the Examiner simply states the Sewall and Huang “teach multiple autocorrelation thresholds and comparison based upon the autocorrelation calculation” (Office Action, page 4).

This is mere hand-waving by the Examiner. Neither Sewall nor Huang individually or in combination teach or suggest:

that said input signal segment is voice-band data if said first autocorrelation coefficient is less than a first autocorrelation threshold, and that said input signal segment is speech if said first autocorrelation coefficient is greater than a second autocorrelation threshold, said second autocorrelation threshold being greater than said first autocorrelation threshold

(claim 5)

Furthermore, even assuming *arguendo* that the Examiner could construe the use of multiple thresholds in either reference, the references still do not disclose these particular limitations, nor are these limitations inherent. Thus, a *prima facie* case of obviousness cannot be made with regards to claim 5. The Examiner has similarly encapsulated the limitations of claims

6-9. Applicant submits that neither Sewall nor Huang, individually or in combination, teach or fairly suggest the limitations of these claims.

Accordingly, for all of the reasons stated above, Applicant respectfully submits that neither Sewall nor Huang, either alone or in combination, teach, fairly suggest, or render obvious, each and every feature of independent claim 1. For somewhat similar reasons, independent claim 11 is also patentable (although claims 1 and 11 should be interpreted solely based upon the limitations set forth therein).

Claims 2-10 and 12-21 are patentable at least by virtue of their dependency on independent claims 1 and 11.

Applicant respectfully requests the Examiner withdraw this art grounds of rejection.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-21 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$120 extension fee herewith.

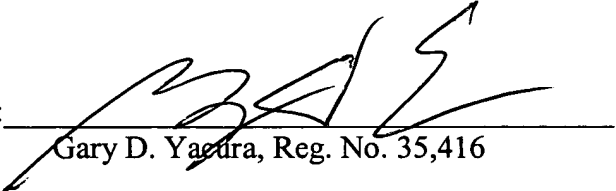
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By: _____


Gary D. Yacura, Reg. No. 35,416

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

GDY/JRS:ach
JRS